

## **REMARKS**

### **Summary of the Office Action**

The declaration has been found defective and a new one has been requested. Claims 1, 2-7, 13 and 21 have been rejected under 35 U.S.C. §112, second paragraph.

Claims 1-3, 7-10 and 14-18 have been rejected under 35 U.S.C. §102(a) as being anticipated by McFarland (U.S. Patent No. 6,154,753).

Claims 4-6, 11-13 and 19-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over McFarland in view of Ivanov (U.S. Patent No. 5,706,452).

### **The Declaration**

It is submitted that Thomas J. Walsh is the sole inventor. However, at this time, a new declaration is not deemed necessary to further review the application. Accordingly, it is respectfully requested that any objection in this regard be held in abeyance until allowable subject matter is identified, at which point an appropriate new declaration shall be provided by the Applicant.

### **35 U.S.C. §112, Second Paragraph**

Regarding the §112 rejections, the claims have been amended to reflect the interpretation suggested by the Examiner in the Office Action. Accordingly, it is respectfully requested that the rejections now be withdrawn.

### **The Current Claims Distinguish Patentably over the References**

As amended, the claims are not anticipated by McFarland. Importantly, McFarland is directed to a general document management system for creating records sufficient to demonstrate conformance to a specified quality control standard. The focus is on a plurality of stored forms in which data is entered to create respective documents. There are no details provided as to how quality control audits are actually carried out. Rather, it is merely stated that an audit management module supports various audit functions without explaining how those functions are implemented or interconnected. For example, the Office Action cites to column 10, lines 34-42 which refers to FIGRE 7. However, all that the passage discloses is that a module exists which plans, executes, and records audits. It generates an audit schedule, supports recording of audit results,

prescribes forms, retains records, supports corrective action plans, and supports verification of action effectiveness. Please note that the term "findings" as used in the passage merely means "results" in general. Importantly, it does not equate with the type of finding as defined in the claims. Also note that merely stating that some process is "supported" is not the same as teaching how the process works.

Notably, claim 1 calls for determining if an audited activity produces a finding, said find representing a deficiency in the audited activity such that an action is mandated to be taken by the organization to correct the deficiency. McFarland teaches no such findings nor making a determination that an audited activity has produced a finding of the type defined. Moreover, claim 2 additionally calls for determining if the audited activity produced an observation, said observation representing (as opposed to a finding) a non-mandatory recommendation regarding the audited activity. Clearly, McFarland teaches no such observations nor making a determination that an audited activity has produced an observation of the type defined. McFarland makes no particular reference to the types of results generated by the audits, and clearly makes no distinction between two defined types of results such as the claimed findings and observations.

Similarly, claims 8 and 9 and 15 and 16 recite and distinguish between particular audit results defined as findings and observations respectively. Again, McFarland does not identify the particular type or distinguish between two the different types of audit results as defined in the claims.

According to MPEP §2131, to anticipate a claim under 35 U.S.C. §102, "the **reference must teach every** element of the claim" and "the **identical invention must be shown in as complete detail** as is contained in the ... claim" and "the **elements must be arranged as required** by the claim." [Emphasis added and citations omitted]. As already pointed out, McFarland does not teach all of the claimed elements, and the identical invention is not shown in as complete detail as is contained in the claims. Moreover, the claimed elements are not arranged as required. Notably, the Office Action takes unrelated passages out of context from various diverse parts of the McFarland reference and recombines them in an attempt to read on the claimed invention. The reference simply does not contemplate such a random reconstruction. Note, in rejecting the claims, seemingly unrelated text is cite from columns 10, 16, 24, 3 and 8.

Additionally, with respect to the rejections under 35 U.S.C. §103(a), Applicant respectfully submits that the Office Action fails to state a *prima facie* case of obviousness. Notably, there is insufficient motivation to support the combination.

The MPEP is instructive as to this point. Per MPEP §2143.01, "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." In the present case, the Applicants have found no teachings, suggestions or motivation to combine in the references themselves. If the Examiner should contend otherwise, Applicants respectfully request that the Examiner explicitly cite the column and line numbers where such teachings, suggestions or motivation may be found.

Additionally, the mere apparent ability to make a given combination does not provide sufficient motivation for making that combination. Again, as noted in MPEP §2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." [Emphasis added]. That is to say, *prima facie* obviousness is not sufficiently established by the fact that references can be combined or modified. The question that must be answered is why would one desire to make the combination or modification. The Examiner's motivation does not answer this question. In fact, the Examiner's only allegation is that the references "can be" combined. This is directly contrary to the accepted practices and the well established law regarding the sufficiency of motivation for combining references under 35 U.S.C. §103. Simply because two or three references are related to the same technology, it does not necessarily mean one of ordinary skill in the art would want to combine them.

Furthermore, according to MPEP §2143.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." Merely because claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. See, MPEP §2143.01 citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Consequently, absent a

motivation to combine or modify the references, it is irrelevant that the elements and/or limitations may be individually or separately taught in the prior art.

Accordingly, all the rejections under 35 U.S.C. §103 are hereby traversed as lacking a proper motivation for the alleged combinations references.

### **CONCLUSION**

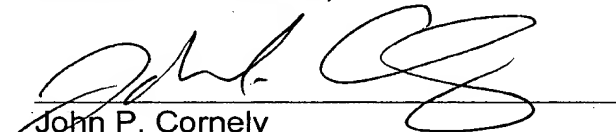
For the reasons detailed above, it is respectfully submitted all claims remaining in the application are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

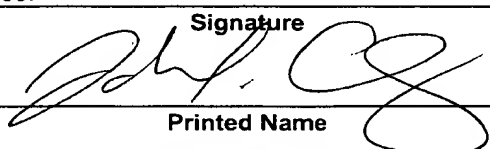
In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone the under signed, at (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

7/21/04  
Date

  
John P. Cornely  
Reg. No. 41,687  
1100 Superior Avenue  
7<sup>th</sup> Floor  
Cleveland, Ohio 44114-2579  
(216) 861-5582

<b>Certificate of Mailing</b>	
<input checked="" type="checkbox"/> Under 37 C.F.R. § 1.8, I certify that this Amendment is being deposited with the United States Postal Service as First Class mail, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.	
<input type="checkbox"/> transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.	
<input type="checkbox"/> deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to the Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
<b>Express Mail Label No.:</b>	<b>Signature</b> 
<b>Date</b> <u>July</u> <del>June</del> 21, 2004	<b>Printed Name</b> John P. Cornely

N:\LUTZ\200053\VIEW0001603V001.doc